Supreme Court, U.S.
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No. 01-186

IN THE

Supreme Court of the United States

NATIONAL GEOGRAPHIC SOCIETY,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.
and MINDSCAPE, INC.,

Petitioners,

v.

JERRY GREENBERG and IDAZ GREENBERG,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. **WHETHER THE ELEVENTH CIRCUIT'S OPINION CONFLICTS WITH THIS COURT'S RECENT DECISION IN *NEW YORK TIMES CO. v. TASINI.***

2. **WHETHER THE COURT BELOW CORRECTLY HELD THAT THE COMPLETE NATIONAL GEOGRAPHIC ("CNG") QUALIFIES AS A NEW COLLECTIVE WORK THAT IS NOT PROTECTED BY THE PRESUMPTIVE PRIVILEGE IN SECTION 201(c) OF THE COPYRIGHT ACT.**

3. **WHETHER FOOTNOTE 13 IN THE ELEVENTH CIRCUIT'S OPINION HAS ANY RELEVANCE TO THE HOLDING IN THE CASE DECIDED BELOW THAT WARRANTS REVIEW.**

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STATEMENT OF THE CASE

Respondents do not adopt the Statement of the Case submitted by Petitioners. Respondents do adopt, for purposes of this brief in opposition, the "Background" portion of the opinion prepared by the Eleventh Circuit, with exceptions noted below. *See* 244 F.3d at 1268-71. That opinion is attached to the petition as Appendix A.

The CD-ROM product that is the focus of the litigation is in the record below. In their argument, Respondents refer to the product — "108 Years of the Complete National Geographic" — as the "CNG."

The Eleventh Circuit identified the component elements of the CNG as: (a) the "Replica," consisting of reprints of the 1200-plus monthly magazines themselves, (b) the "Sequence," consisting of the electronic morphing of ten covers from selected issues of the monthly magazine that appears when each disc is opened, and (c) the "Program," which permits the CD-ROM discs to display graphic and aural materials and which performs other functions. That depiction of the CNG's components was factually adequate for the conclusions drawn by the court. But the CNG contains other materials and other capabilities that even more forcefully support the Eleventh Circuit's holding of infringement, including the following:

- An animated globe logo with music
- A National Geographic Interactive visual montage with sound
- A Kodak advertisement with voice and music

- An electronically-morphed sequence of magazine covers with music
- Word-search capability
- Advanced search capability using Boolean operators, wildcards, truncated words
- Feature for saving search results
- Article-by-article inspection
- An interactive link with the NGS web site
- A bookmark feature
- A button for printing any page displayed on screen

Each of those elements and capabilities is readily visible to, or available to, an end user of the CNG. Petitioners' assertion (Pet. at 5) that the CNG "does not provide a means for the user to separate the photographs from the text or otherwise to edit the pages in any way," is not correct. The product's program does not provide that means, but the universal file format codes utilized in the product provide an easy means for an end user to open, edit and copy particular pages for manipulation.[1]

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1. Similarly, the Eleventh Circuit's observation that "the CNG does not provide a means for the user to separate the photographs from the text or otherwise to edit the pages in any way" is not correct. 244 F.3d at 1269.

The Petitioners' discussion of microfilm and microfiche, and particularly of the characteristics and capabilities of such microform reproduction, is supported by no record evidence of any kind.

The letter from the U.S. Copyright Office that is included in Appendix D to the petition did not appear spontaneously but was solicited, as the letter itself indicates, through an inquiry from the National Geographic Society. The letter was stricken by the Eleventh Circuit on motion by the Respondents, and is not in the record below.

The copyright registration attached to the Eleventh Circuit's opinion as Appendix A, *see* 244 F.3d 1267 (11th Cir. 2001), identifies the title of the work to be registered as "108 Years of National Geographic Magazine on CD-ROM," identifies 1997 as the year of completion of the work (the most recent monthly magazine included in the CNG was from 1996), and indicates that the work being registered, and any earlier version of the work, had not been registered before.

REASONS FOR DENYING THE WRIT

Introduction

The Court should deny the writ because: (1) there is no conflict with any decision by this Court or any other, and (2) the Eleventh Circuit correctly ruled on the facts and the law before it.

In their zeal to gain entry to the Court, the Petitioners rely almost totally on what they assert to be a conflict between *Greenberg v. National Geographic Society*, 244 F.3d 1267 (11th Cir. 2001), and *New York Times Co. v.*

Tasini, 121 S. Ct. 2381 (2001). In the process, as will be apparent below, they distort this Court's holdings and discussion in *Tasini* beyond recognition. The very notion of "conflict" between the two decisions is meaningless because the Petitioners are misreading, and omitting, what the Court said in *Tasini*.

Moreover, the facts in the two cases were strikingly different. Both courts ultimately concluded that the publishers had failed to satisfy any of the requirements contained in Section 201(c) of the Copyright Act, 17 U.S.C. § 201(c), for application of the presumptive privilege set forth in that section. Both courts affirmed authors' *rights* to a continued interest in their copyrighted works, subject only to the limited and presumed *privilege* for publishers in Section 201(c). That section says that a publisher of a collective work, such as a magazine,

> is presumed to have acquired only the privilege of reproducing and distributing the [author's] contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

17 U.S.C. § 201(c). Both courts relied on the same House Committee Report that in 1976 explained the decade-long evolution of the presumptive privilege in Section 201(c):

> [A] publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution

> itself or include it in a new anthology or an entirely different magazine or other collective work.

H.R. Rep. No. 94-1476 at 122-23 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738 [hereinafter "House Report"]. The House Report is quoted and relied on in *Tasini*, 121 S. Ct. at 2389, and in *Greenberg*, 244 F.3d at 1273.[2]

This brief will demonstrate that the holdings of *Tasini* and *Greenberg* are consistent, the "conflicts" that Petitioners point to are chimerical, and that *Greenberg* was properly decided.

I. THE PETITIONERS' ATTEMPTS TO CHARACTERIZE *GREENBERG* AS IN "CONFLICT" WITH *TASINI* FAIL BECAUSE THE OUTCOMES IN THE CASES ARE CONSISTENT

A. The Context Discussion

The Petitioners focus on the *Tasini* Court's discussion of "context" in relation to Section 201(c). In the Petitioners' view, "[a]s long as each individual contribution remains in its 'original context,' the publisher has not infringed the author's copyright." Pet. at 2. The Eleventh Circuit, they contend, was in error in finding infringement because

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2. Notwithstanding that both courts cited to the legislative history, the Petitioners attempt to downplay its role here. Courts have no authority, says their brief, to enforce a principle gleaned solely from legislative history that has no statutory reference point. (Pet. at 14.) But the link between the House Report and Section 201(c) could not be more obvious, and both courts acknowledged that linkage.

the Greenberg photographs remain in context in the CNG. Very much to the contrary, the court below held that the CNG was far removed from the context in which the Greenberg photographs first appeared, because: (a) the photographs now appear in a new collective work — the CNG — forbidden under Section 201(c), and (b) because the photographs did not appear in a context contemplated in the statute. The "context" issue is thus no issue at all.

The Court's opinion clearly explains its reference to "context" when the word is first used there:

> [T]he three Databases present articles to users clear of the context provided either by the *original periodical editions* or by any *revision of those editions*. . . . We cannot see how [any of the databases] perceptibly reproduces and distributes the article "as part of" either the original edition or a "revision" of that edition.

121 S. Ct. at 2390-91 (emphasis added).

The Court's use of "context" in its discussion thus relates directly to the exact words used in Section 201(c). A publisher intending to rely on the privilege stated there must heed the literal re-publishing context specified in that section.

As described more fully below, the Eleventh Circuit held that the CNG is *not within the context of any of the permissible reproductions* in Section 201(c). The legislative language in the House Report amplifies what the phrases in that section mean, and provides both permitted and prohibited examples. Congress said that a publisher could reprint a contribution from one issue in a later issue of its magazine

("the same series"),[3] or reprint the contribution intact from an earlier edition in a later edition of an encyclopedia. The publisher could not revise the contribution itself, or include it in a new anthology or an entirely different magazine or other collective work.

The *Tasini* Court similarly concluded, in a vital passage completely ignored by the Petitioners:

> It would scarcely "preserve the author's copyright in a contribution" as contemplated by Congress, if a . . . magazine publisher were permitted to reproduce or distribute copies of the author's contribution *in isolation* or within *new collective works*.

121 S. Ct. at 2389 (citations omitted) (emphasis added). Thus the Court said that the context requirement of Section 201(c) can be violated in two ways. One is by lifting a contribution out of the context in which it first appeared to an end user, and placing it in isolation. In *Tasini*, that involved the immersion of individual articles in isolation in vast databases. A violation also can occur, under the Court's proscription, by placing the contribution in a new collective work. Such a work would not fit within any of the permitted uses, or contexts, in Section 201(c). Not surprisingly, Petitioners embrace the first prohibition stated by the Court, and casually brush aside the second.

With respect to this Court's admonition quoted above, a magazine publisher cannot reproduce or distribute copies of

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3. To illustrate, a copyrighted photograph by Jerry Greenberg that appeared in the January 1962 issue of the Society's magazine was lawfully reprinted in the July 1990 issue of the magazine.

the author's contribution *in isolation* or within *new collective works*. *Tasini* involved issues of isolation; *Greenberg* involved a new collective work. Both violated Section 201(c). The issues were different, but the outcomes are not in conflict.

Petitioners, straining to circumvent the express prohibition against inclusion of the Greenberg photographs in a new collective work, attempt to create an exception to the prohibition where the author's contribution, and the original collective work in which it first appeared, are incorporated in a new collective work. (Pet. at 16). However, Petitioners do not and cannot point to any language — statutory, Congressional, or in case law — carving out such an exception. Similarly, there is no exception to the express prohibition involving new collective works merely because an author's contribution remains in the "context" in which it was originally published. This Court, in *Tasini*, acknowledged and adopted the legislative prohibition: no publisher, in a Section 201(c) application, should be "permitted to reproduce or distribute copies of the author's contribution . . . within new collective works." 121 S. Ct. at 2389. The Court's discussion of context with reference to the "in isolation" issue did not reach, much less diminish, the import of the prohibition against new collective works.

Thus, a "new collective work" may contain a whole issue of a magazine, or many issues, as the CNG does. *It is still a new collective work*. Neither the House Report, nor this Court, both cautioning against republication in a "new collective work," imposes any requirement or limitation as to the contents of such a work. What constitutes a "new collective work" is a matter of law to be determined within

the definitional framework of the Copyright Act, and the Eleventh Circuit correctly made that determination, as set forth below.

The Petitioners urge that, because the *Tasini* Court did not examine whether the databases there comprised a new collective work, this Court considered that analysis unimportant in any setting. However, the Court's finding that the authors' articles were reproduced in total isolation meant that none of the three permissible uses in Section 201(c) could possibly apply. Therefore, it was not necessary for this Court to reach the issue whether the databases containing the news articles also constituted new collective works.

In the matter of context, *Greenberg* could not be more aligned with *Tasini*.

B. The Microform Comparison

Completely contrary to the Petitioners' assertion, the *Tasini* Court did not hold that microform (microfilm or microfiche) reproduction qualifies for the Section 201(c) privilege. Arguably, such reproduction may qualify, but *that issue was not before the Court and the Court did not decide it.*[4] The topic provides no basis to suggest a "conflict" with *Tasini*.

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4. Because microform is utilized almost exclusively for archival purposes in libraries, it is likely that the question has never been litigated. Even the Petitioners agree (Pet. at 17 n.3) that "very few (if any) individuals buy microfilm or microfiche . . . ." *See also* 121 S. Ct. at 2392 n.12, where the Court emphasizes that the Copyright Act, in Section 108, provides special authorizations to libraries for the very limited reproduction of works for purposes related to scholarship and research.

Microform arose in the Court's discussion of the "context" contemplated in Section 201(c), wherein the Court observed that an end user confronts the authors' articles in the databases at issue in *Tasini* "disconnected from their original context." 121 S. Ct. at 2391. The only "original context" for an author's article was the newspaper — the collective work — in which it originally appeared. By comparison with the databases, the Court observed that an end user rolling through a spool of microfilm encounters the authors' articles in context, "in precisely the position in which the articles appeared in the newspaper." *Id.*

The Petitioners seize on that language to propose that "the *Tasini* Court went out of its way to note that the reproduction of a collective work in microfilm or microfiche ["microform"] *does* qualify for the privilege" (Pet. at 10 (emphasis in original)). First, the Court did not so hold. Second, even if it had, the microform described by the Court would present an end user with the original context of "that particular collective work" referenced in Section 201(c). As the Eleventh Circuit correctly held, the CNG went far beyond any "original context" attached to "that particular collective work," *i.e.*, a monthly magazine.

The CNG is as comparable with microform as a race car is to a horse. As explained next, the CNG contains crucial elements not present in microform reproductions.[5]

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5. Petitioners suggest that microform reproductions also include "independently copyrightable" elements such as an introductory page and an index. (Pet. at 13.) Whether such elements are copyrightable is highly questionable. In any event, the record below contains no evidence whatsoever as to microforms, and the facts utilized on the subject by the Petitioners are gratuitous and inappropriate for argument to this Court.

C. Reproduction in CD-ROM, a Different Medium, is Not an Issue

In an extraordinary misstatement, Petitioners assert that *Greenberg* "gives freelancers the power to stop publishers from creating electronic archives of their collective works." (Pet. at 2). The Eleventh Circuit *did not hold* that reproduction of the Greenberg photographs in a different, electronic medium would be inherently impermissible.

In *Tasini*, the Court said that "unlike the conversion of newsprint to microfilm, the transfer of articles to the Databases does not represent a mere conversion of intact periodicals . . . from one medium to another." 121 S. Ct. at 2392. Similarly, the Eleventh Circuit said: "The Society characterizes this case as one in which there has merely been a republication of a preexisting work, without substantive change, in a new medium . . . [H]owever, this case is both factually and legally different than a media transformation." 244 F.3d at 1273 n.12. Because in *Greenberg* the end user encounters significant new elements in a completely new collection, the conversion of magazines into the CNG is also not a "mere conversion of intact periodicals," as this Court observed in *Tasini*. 121 S. Ct. at 2392.

With more than a touch of hyperbole, Petitioners imply that the Eleventh Circuit has adopted a Luddite view of technology. The outcome in *Greenberg*, they propose, would stop publishers from using technological advances and return publishing to the dark ages. (Pet. at 13). The Eleventh Circuit said nothing to support such a draconian outcome. Every CD-ROM does indeed require at least minimal software to permit page-by-page access to printed matter reproduced in a digital format. But the CNG goes far beyond what is

minimally necessary in digital technology. Each of the 30 discs in the product contains features that no microform reader at the local library will ever see, including the following:

- An animated globe logo with music
- A National Geographic Interactive visual montage with sound
- A Kodak advertisement with voice and music
- An electronically-morphed sequence of magazine covers with music
- Word-search capability
- Advanced search capability using Boolean operators, wildcards, truncated words
- Feature for saving search results
- Article-by-article inspection
- Interactive link with the NGS web site
- Bookmark feature
- Button for printing any page displayed on screen[6]

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6. The Petitioners told the Eleventh Circuit that the copy quality was inferior, and provided examples. (Brief in Opp. to Initial Brief, Ex. A.) Greenberg demurred, and filed with the court samples of high-quality color copies printed from the CNG product. (Reply Brief of Jerry Greenberg, Ex. 1.)

Those items[7] are not essential for a CD-ROM product created only for page-by-page screening of magazines, *as a microform user would expect to find*. Instead, as the Eleventh Circuit properly found, they announce that the CNG is a "new product ('an original work of authorship'), in a new medium, for a new market that far transcends any privilege of revision or other mere reproduction envisioned in § 201(c)." 244 F.3d at 1273. The transfer to a different medium has nothing to do with the ultimate issue.

Significantly, the Court in *Tasini* found two CD-ROM products to be infringing — *not* because they involved digital technology, but because they reproduced news articles in a manner outside the privilege provided in Section 201(c). *See* 121 S. Ct. at 2382, 2394.

The medium is not the issue. The creation of a new collective work guided the Eleventh Circuit's finding of copyright infringement.

II. THE ELEVENTH CIRCUIT'S DECISION IS FULLY CONSISTENT WITH SECTION 201(c) AND ITS LEGISLATIVE HISTORY

A. Two Bases for the *Greenberg* Conclusion

The Eleventh Circuit identified three components of the new collective work. The 1200-plus monthly magazines (each is a separate collective work) were labeled by the court

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7. While the Eleventh Circuit did not specifically address each of the Program features in the list above, those features are part of the Replica, the Sequence, and the Program discussed at length by that court. Many of the features listed are separately copyrightable.

as "the Replica." Another element is the morphing sequence of moving covers that appears at the front of each disc and plays each time a disc is opened; the court called it "the Sequence" (as discussed below, the Sequence is the basis for a completely separate claim by Greenberg). A third element, referred to by the court as "the Program," consists not only of the basic software that permits each page of each magazine to be displayed in turn, but all of the myriad additional features listed above that go far beyond basic software necessary for the CD-ROM to operate.[8]

The Eleventh Circuit ruled that the CNG was a new work outside the privilege in Section 201(c) on two bases: a failure to satisfy the statutory language set forth in that section, and a failure to avoid the Congressional prohibition.

First, the court said that, even if the aggregated 1,200 issues of the magazine themselves — what the court called the Replica — could be said to be within the privilege (the court expressly did not decide), "*we are unable to stretch the phrase 'that particular work' [in Section 201(c)] to encompass the Sequence and Program elements as well.*"[9] 244 F.3d at 1272 (emphasis and bracketed material added). Second, the court held that the CNG, with its component

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8. In the court below, the Petitioners — searching for the viability of *some* part of Section 201(c) — began referring to the CNG as a product that may satisfy the "revision" clause. The court responded succinctly by saying that "[i]n layman's terms, the instant product is in no sense a 'revision.' " 244 F.3d at 1272. Petitioners reassert the proposition in their brief. (Pet. at 9).

9. Petitioners stated that the court below "made no effort to tie [its] holding to the language of the statute . . . ." (Pet. at 6). The passage in the text above, quoted from the opinion, belies that.

elements of Replica, Sequence, and Program, qualifies under the Copyright Act as a collective work, and moreover, that work is new. *Id.* That, said the court, runs afoul of the Congressional direction that contributions such as Greenberg's photographs may not be placed in a new and different collective work. *Id.*

It is undisputed that if the Petitioners had merely reprinted "that particular collective work" — the four monthly magazines in which Greenberg's photographs appear — they would have availed themselves of the presumptive privilege in Section 201(c). But Petitioners did much more.

It is helpful to review the definition of "collective work" set forth in the Copyright Act. "A collective work is a work, such as a periodical issue, anthology,[10] or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." 17 U.S.C. § 101. Here, the CNG is unquestionably a new "work" in which a number of contributions — consisting of hundreds of separate and independent magazines, *and other creative elements* — are assembled into a collective whole. The CNG, the Eleventh Circuit said, is a new work "that is copyrightable as an entity separate and distinct from its constituent, pre-existing separately copyrightable contributions." 244 F.3d at 1271.

In reaching that conclusion, the Eleventh Circuit relied, among other things, on the National Geographic Society's

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10. The House Report, at 122-23, said that a publisher could not include an author's contributions "in a new *anthology* or an entirely different magazine or other collective work." (Emphasis added). If nothing else, the CNG qualifies as an anthology.

admissions in a registration form filed in 1998 with the Copyright Office. The form shows that: (a) the work being registered was a product titled "108 Years of National Geographic Magazine on CD-ROM," (b) the work had never existed before, and (c) the new work was a "compilation." 244 F.3d at 1273 and App. A thereto. The court noted that a collective work is encompassed in the statutory definition of a compilation. *Id.* In *Apple Barrel Productions, Inc. v. Beard*, 730 F.2d 384, 388 n.6 (5th Cir. 1984), the court observed that "[c]ompilations consisting of contributions which are themselves 'works' capable of copyright protection are called 'collective works.' " *See also Southern Bell Tel. & Tel. v. Assoc. Telephone Directory Publishers*, 756 F.2d 801, 810 (11th Cir. 1985) ("a collective work is itself a compilation").

In their brief filed below, Petitioners never acknowledged the admissions contained in the registration form. They also avoided the matter entirely in their petition, disparaging the Eleventh Circuit's interest in the registration form as "a frolic and detour." (Pet. at 19.) Petitioners cannot evade the reality that they registered a work, that had never existed before, as a compilation in the form of a collective work — as the Copyright Act and the courts define those terms. Petitioners lately have attempted to cloud the matter of exactly what was registered with the Copyright Office.[11] However, in a memorandum filed with the district court below, Petitioners represented to the court as follows: "[T]he work registered in the Form VA was CD-ROM 108 — not the Moving Cover

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11. Petitioners state that the Society claimed copyright only in a "brief introductory audiovisual montage," an apparent reference to the Sequence. (Pet. at 5). The representation to the district court below conflicts directly.

Sequence. In registering its copyright interest in CD-ROM 108, the Society, in the interest of full and fair disclosure, merely indicated the presence of a small amount of material in addition to that which existed previously."[12]

If, as Petitioners contend, the CNG is nothing more than a huge bundle of reprints of magazines (each is protected by its own copyright registration), why would registration of the entire new product be necessary? "Copyright in [a] collective work vests in the collective author (here . . . the magazine publisher) and extends only to the creative material contributed by that author, not to 'the preexisting material employed in the work.' " 121 S. Ct. at 2387 (quoting 17 U.S.C. § 103(b)). The Society would hardly seek protection for something new that it did not consider valuable and deserving of protection. The Eleventh Circuit rightly concluded that the registration was of a completely new collective work, which is not protected by Section 201(c).

Finally, to emphasize what they believe to be the Eleventh Circuit's improper reliance on the congressional admonition against new collective works, Petitioners suggest that the House Report itself authorizes new collective works, such as "a later issue of its magazine" and the publication of a new edition of an encyclopedia. (Pet. at 16.) Those are express, narrow exceptions to the prohibition against inclusion of an author's work in an "entirely different magazine or other collective work." House Report at 122-23. A "later issue" and a "new edition" are not the same

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12. *See* Defendants' Motion to Strike Plaintiffs' Supplemental Memorandum in Support of Plaintiffs' Motion to Vacate Order Granting in Part Defendants' Motion for Summary Judgment at 6 (Docket number 68).

thing as an "entirely different magazine or other collective work." As the *Tasini* Court observed, "[s]ection 201(c) both describes and circumscribes" the privilege available there. 121 S. Ct. at 2389.

B. The Speculation About Harm is Misplaced

Escalating the argument that the Eleventh Circuit's decision will return publishing to an ancient time, Petitioners urge that if a computer program is sufficient to defeat the privilege, "then Section 201(c) would *never* permit the reproduction of collective works in CD-ROM or other electronic media" (Pet. at 13 (emphasis in original)). Such concerns were directly repudiated by the Court in *Tasini*: "[S]peculation about future harms is no basis for this Court to shrink authorial rights Congress established in § 201(c)." 121 S. Ct. at 2394.

Despite Petitioners' foreboding, publishers are always free to employ digital technology, in circumstances where Section 201(c) is involved, in two stratagems. First, a publisher wanting to reproduce an author's work in a digital format can satisfy Section 201(c) by utilizing a software program that simply stores the work and allows page-by-page display.

Alternatively, a publisher is quite free to include all kinds of marketable elements, like those in the CNG, to create new collective works or anthologies that are outside the Section 201(c) privilege. In that circumstance, the publisher may deal with an author's copyrighted contributions by negotiating payment for their use, through royalties or a similar arrangement — steps that Petitioners never claim to have attempted here. In such situations the parties, said the Court,

"may draw on numerous models for distributing copyrighted works and remunerating authors for their distribution." 121 S. Ct. at 2393.

Petitioners complain that in a retroactive sense "it is impossible as a practical matter for . . . publishers (like National Geographic) to reach retroactive license agreements with all of their past freelance contributors." (Pet. at 17). Petitioners do not bother to explain why it is impossible. The only outcome, they exclaim, is the "destruction" of a valuable historical archive like the CNG. *Id.* The publishers in *Tasini* also raised the specter of destruction, but the Court rejected such "dire predictions." The Court said that it hardly follows that an injunction must issue to bar continued use of the authors' articles. 121 S. Ct. at 2393. The *Tasini* and *Greenberg* courts said that injunctions that would require removal of contributors' works were not foregone outcomes on remand to the district courts. In *Greenberg*, the court said: "In assessing the appropriateness of any injunctive relief, we urge the [district] court to consider alternatives, such as mandatory license fees, *in lieu of foreclosing the public's computer-aided access to this educational and entertaining work*." 244 F.3d at 1276 (emphasis added). Those are not the words of an anti-technology court.

Lost in all of the alarms about the handcuffing of publishers is the necessity to preserve the copyright balance set forth in the Constitution[13] by protecting authors' legitimate rights. The *Tasini* Court observed that Section

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13. Article II, Section 8, provides in pertinent part: "The Congress shall have Power . . . To promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings."

201(c) "adjusts a publisher's copyright in its collective work [here, a monthly magazine] to accommodate a freelancer's copyright in her contribution. If there is demand for a freelance article standing alone *or in a new collection*, the Copyright Act allows the freelancer to benefit from that demand . . . ." 121 S. Ct. at 2389 (emphasis added).

III. THE "FRAUD" ISSUE RAISED BY THE PETITIONERS IS WHOLLY INAPPROPRIATE FOR REVIEW HERE

Only two questions were presented by Petitioners for the Court's consideration. The second question reads as follows:

> Whether an applicant for a copyright registration perpetrates a "fraud" on the Copyright Office when the applicant discloses "the material . . . in which copyright is claimed," as the Copyright Office requires, and the Copyright Office itself insists that the applicant provided full disclosure.

Pet. at 2. The question is a marvel of irrelevance. The subject matter was addressed by the Eleventh Circuit in footnote 13 of its decision, and nowhere else. The discussion in the footnote is dictum that in no way was relevant or essential to the court's holding of copyright infringement. The point requires no elaboration. This Court should reject the issue out of hand.

Petitioners even got the dictum wrong, in their assertion that in footnote 13 the Eleventh Circuit "accus[ed] National Geographic of having 'perpetrated a fraud' on the Copyright Office . . . ." (Pet. at 18.) The court below did not go so far.

It said: "Giving the Society the benefit of the doubt, it may not have intentionally perpetrated a fraud on the Copyright Office." 244 F.3d at 1273 n.13. Petitioners twisted that sentence into the following: "The [Eleventh Circuit] then accused the Society of having 'perpetrated a fraud on the Copyright Office' " — albeit, "[g]iving the Society the benefit of the doubt," perhaps "not . . . intentionally." (Pet. at 19.)

Petitioners make a weak attempt to relate the contents of footnote 13 to the Eleventh Circuit's holding with respect to a new collective work. (Pet. at 19.) But in the discussion by the court below of the registration filing, *see* 244 F.3d at 1273, what appears in footnote 13 of that opinion is simply an aside that touches on a question that was not before the court.

Of some moment, however, is that Petitioners improperly have included in their appendix a letter from the Copyright Office that was obtained ex parte after the Eleventh Circuit's opinion issued, was excluded by the court from the record below, is not suitable for judicial notice (the general counsel's letter responded to a letter of inquiry by the Society), and that contains commentary on substantive matter pertaining to this case entirely apart from the "fraud" issue. The letter should be stricken or ignored.

Item 2 in "Questions Presented" falls far short of any of the criteria generally understood to be the basis for certiorari review by this Court.

IV. THE RULING ON GREENBERG'S SECOND CLAIM BELOW HAS NOT BEEN CHALLENGED AND SHOULD NOT BE DISTURBED

In a completely separate claim in his complaint, Respondent Jerry Greenberg also alleged an infringement of his copyright in a photograph that became part of what his lawsuit called the Moving Cover Sequence which is displayed at the start-up of each CD-ROM disc in the CNG. What the Eleventh Circuit referred to as "the Sequence" is an artfully designed electronic "morphing" of ten covers selected from among the 1200-plus magazines in the CNG.

The Eleventh Circuit held that the Sequence is "at once a compilation, collective work, and with reference to the Greenberg photograph, a derivative work" that infringes Greenberg's copyright in the photograph that was used. 244 F.2d at 1274.

Petitioners did not identify that holding of infringement with the other "Questions Presented" in their brief, and thus waived any challenge to the holding. The *only* tangential discussion in the petition of Greenberg's claim regarding the Sequence is in footnote 2, where Petitioners contend that the Eleventh Circuit's "erroneous interpretation of Section 201(c) necessarily infected its fair use and *de minimis* analysis as well . . . ." (Pet. at 17 n.2). The brief incorrectly states that the holding by the court below "was expressly based in part on the court's conclusion that the 'moving covers' sequence was 'an integral part of a larger, new collective work' outside the scope of Section 201(c)." *Id.* (citation omitted). What the court actually said was otherwise: "[Greenberg's photograph] became an integral part of a larger, new collective work." 244 F.3d at 1274.

The "larger" work referenced in that discussion was the Sequence. In its analysis of the Sequence the court never mentioned Section 201(c), nor was that section ever raised by the Petitioners below as a justification for using Greenberg's photograph in the Sequence.

Petitioners did not challenge in their brief in any way the Eleventh Circuit's analysis and rejection of their *de minimis* and fair use defenses with respect to the Sequence. The only basis proposed in the petition in footnote 2 for review by this Court is some purported linkage between the separate Sequence claim and Section 201(c). The Eleventh Circuit attempted no such linkage, nor did the Petitioners themselves in briefing that court. The Eleventh Circuit's holding with reference to the Sequence claim should not be disturbed.

CONCLUSION

The *Tasini* Court's ultimate conclusion bears repeating: "It would scarcely 'preserve the author's copyright in a contribution' as contemplated by Congress, if a . . . magazine publisher were permitted to reproduce or distribute copies of the author's contribution in isolation or within *new collective works*." 121 S. Ct. at 2389 (citations omitted) (emphasis added).

The Eleventh Circuit's holding that, as a matter of law the CNG is a new collective work, was consistent with this Court's conclusions as to the law. As such, the CNG is beyond the privilege contained in Section 201(c), and the Eleventh Circuit's opinion is solidly grounded in law. Respondents submit that *Greenberg* requires no review here.

Respectfully submitted,

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